

Claims 1-339¹ are pending in this application, with claims 1, 24, 26, 27, 28, 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 being independent. Claims 1-83, 296-301, 308-313, and 320-325 have been allowed. Claims 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319, and 326-331 have been withdrawn from consideration as being drawn to non-elected species.

Applicant continues to believe that the Examiner's withdrawal of at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 is improper because these claims either read on the elected species or were not subject to any of the species-election requirements applied in the Office Action dated March 22, 2006. Despite Applicant's extensive arguments filed on November 14, 2006 and May 16, 2007, the Examiner has not fully responded to Applicant's arguments. Nor has he provided any logical explanation as to why those claims are not readable on the elected subject matter. Thus, as a final resort to resolving this issue, Applicant concurrently files a Petition under 37 C.F.R. §§ 1.144 and 1.181, requesting the Group Director to reconsider the Examiner's improper claim withdrawal.

In the final Office Action, the Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295, and 332-335 under 35 U.S.C.

¹ Applicant notes that claims 336-339 were not included in the listing of pending claims in the Office Action Summary. See item 4). However, these claims were rejected in the Detailed Action section. Therefore, Applicant believes that this omission was inadvertent and that the claims should have been included in the claim listing. Applicant respectfully requests clarification of this discrepancy in the next Office communication to Applicant.

§ 102(b) as allegedly being anticipated by U.S. Patent No. 4,403,624 to Montgomery ("Montgomery"). The Examiner also rejected claims 336-339 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Montgomery. In addition to these art rejections, the Examiner rejected, under 35 U.S.C. § 251, claims 84-339 as being an alleged improper recapture and claims 30-83 as allegedly containing "[sic] 35 USC 251 no error." The Examiner further alleged that the reissue declarations filed on October 29, 2001 and December 21, 2006 are defective. Applicant respectfully traverses all of these rejections for the reasons explained below.

Finality of Office Action

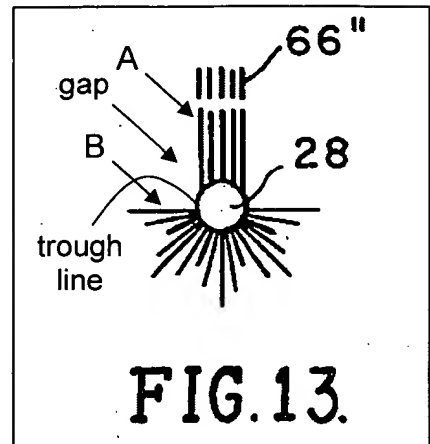
As an initial matter, Applicant notes that the 35 U.S.C. § 251 rejections, briefly discussed above, were raised by the Examiner for the first time in this final Office Action. Also, these rejections were not necessitated by Applicant's Amendment filed May 16, 2007. Consequently, the finality of this final Office Action unfairly and prematurely precludes Applicant's opportunity to fully respond to the new grounds of rejection. For at least this reason, the finality of this final Office Action is in error and should be withdrawn.

35 U.S.C. § 102(b) Rejection

In the final Office Action, the Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295, and 332-335 under 35 U.S.C. § 102(b) as allegedly being anticipated by Montgomery. Applicant disagrees with this rejection.

Montgomery discloses applicators for applying cosmetics to the eye lashes. The Examiner's rejection relied on the embodiment shown in Figs. 11-13, which discloses an

applicator that includes a handle portion 26, a rod 28 extending from the handle portion 26, and a brush portion located on an end of the handle portion 26. The brush portion includes teeth 66" affixed to the rod 28. The Examiner asserted that the handle portion 26 and the teeth 66" of Montgomery correspond to the recited "elongated core" and "bristles," respectively. In addition, the Examiner



asserted that "the gap between the bristles" corresponds to the recited "notch" and that the side faces of the teeth 66" (see "A" and "B" shown in annotated Fig. 13 above) correspond to the recited "front face" and "back face," respectively. Also, the Examiner asserted that side faces "A" and "B" intersect one another at "the line that divides the bristles."

Without necessarily acquiescing to the Examiner's characterizations of Montgomery, Applicant submits that, even assuming, *arguendo*, that side faces "A" and "B" intersect at "the line that divides the bristles," that line is not "spaced away from the core," as recited in each of independent claims 84, 127, 170, 201, 233, 264, and 332-335. Instead, the alleged "line that divides the bristles" is on the rod 28, as clearly shown in Fig. 13.

Nonetheless, without even providing any factual support or any logical explanation, the Examiner alleged that "[a] gap is formed between the bristles and that gap is space[d] away from the core" (final Office Action at 11-12) and maintained this 35 U.S.C. § 102(b) rejection. While it is questionable as to what the Examiner intended to convey with this statement about the purported "gap," Applicant notes that the

statement is completely irrelevant. For example, each of independent claims 84, 127, 170, 201, 233, 264, and 332-335 recites that the trough line at which the front and back faces intersect is “spaced away from the core.” That is, the claims recite that it is the trough line, not a “gap,” that is spaced away from the core. Therefore, whether or not a “gap” is spaced away from the core of Montgomery is completely irrelevant in determining whether Montgomery has any trough line that is spaced away from a core.

For at least this reason and other reasons set forth in Applicant’s prior response filed March 16, 2007, Applicant continues to submit that the claims patentably distinguish from Montgomery. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Montgomery.

35 U.S.C. § 103(a) Rejection

The Examiner also rejected new claims 336-339 under 35 U.S.C. § 103(a) based on Montgomery. Claims 336-339 depend from independent claims 332-335, respectively. Therefore, claims 336-339 also patentably distinguish from the disclosure of Montgomery at least by virtue of their respective dependency from independent claims 332-335. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) based on Montgomery.

35 U.S.C. § 251 Rejections

The Examiner rejected claims 84-339 under 35 U.S.C. § 251 as being an alleged improper recapture of subject matter surrendered during prosecution of the application that matured into U.S. Patent No. 5,918,994 (“parent patent”). Specifically, the Examiner alleged that, during prosecution of the parent patent, Applicant purportedly amended the original claims to add the recitations “non-concave notch back” and “two

secant faces of the notch [being] asymmetric and [forming] a trough line” and allegedly argued the importance of these added recitations. See page 9 of final Office Action. Based on these allegations, the Examiner alleged that claims 84-339 attempt to recapture surrendered subject matter because the claims omit the same claim limitations added in the application that matured into the parent patent. Applicant respectfully disagrees with the Examiner’s allegations.

The Examiner appears to be alleging that the features of a non-concave notch back and two secant faces being asymmetric and forming a trough line have been surrendered because they were either added in claim amendments or argued in remarks submitted in the application that matured into the parent patent. Even assuming, *arguendo*, that these features were indeed surrendered (a notion that Applicant does not necessarily agree with), Applicant notes that there still can be no recapture since reissue claims 84-339 recite all of these allegedly surrendered features. More specifically, independent claims 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 each include the allegedly surrendered features as follows:

Claim 84:

- “the at least one notch comprising a front face and a back face, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 127:

- “the at least one notch comprising a front face and a back face, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 170:

- “the at least one notch comprising a front face and a back face, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 201:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 233:

- “the at least one notch comprising a front face and a back face, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 264:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 332:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 333:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 334:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 335:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

As such, Applicant submits that the Examiner's allegation that the claims omit the same limitations added in the application for the parent patent is erroneous and unsupportable. For at least these reasons, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 251 should be withdrawn.

Worth noting is the Examiner's additional allegation that “[t]he criticality of such ‘two asymmetric faces [forming] a reentrant angle beta at trough line’ is also discussed.” See page 9 of final Office Action. It is unclear whether the Examiner is alleging that the feature of forming a “reentrant angle” is another example of purportedly surrendered subject matter. Nonetheless, Applicant notes that this feature was neither added nor argued during prosecution of the application for the parent patent and, therefore, should not be subject to the recapture rule. For example, in support of his allegation, the Examiner appears to have relied on remarks filed by Applicant on September 24, 1998 and also the Examiner's statement of reasons for allowance of November 19, 1998.

Applicant notes, however, that neither the September 24, 1998 remarks by Applicant nor the Examiner's statement includes any comment reflecting the so-called “criticality” of two asymmetric faces forming a reentrant angle at a trough line. To the

contrary, the only mention of the two asymmetric faces forming a reentrant angle at a trough line appears in the paragraph bridging pages 4 and 5 of Applicant's September 24, 1998 remarks, which is reproduced below in its entirety:

New independent Claims 32 and 35 [] are based upon the original Claims 1 and 31 but do not include certain unnecessary limitations. These claims are also believed to define over the prior art since they recite that the two secant faces of the notch are "asymmetric" (see page 2, line 11) and form a "trough line." For example, the two asymmetric faces of Figure 1A form a reentrant angle β at the trough line 107, but only the second face forms the emergent angle α with the envelope surface of the brush. This contributes to the formation of open notches giving access to the trough line, which holds the greatest amount of product, and promotes spreading (page 3, lines 16-21). (Emphasis added)

As is abundantly clear, the paragraph refers to the feature of "the two asymmetric faces of Figure 1A form[ing] a reentrant angle" merely to show an example of how the specification provides support for the recited features of "asymmetric" and forming a "trough line." That is, contrary to the Examiner's allegation, there is no discussion of the so-called "criticality" of having a reentrant angle at a trough line. Nor is there any mention of such a feature being necessary to distinguish over the cited prior art. With respect to the Examiner's statement of reasons for allowance, Applicant notes that the statement does not mention anything about the "reentrant angle." Even if it did, the Examiner's statement of reasons for allowance cannot, by itself, provide the basis for establishing surrender and recapture. See, e.g., M.P.E.P. § 1412.02 I.B.2(C), entitled "Example (3) - Who can make the surrendering argument?" For at least these reasons, the feature of the two asymmetric faces forming a reentrant angle at a trough line is not subject to surrender or recapture in this reissue application.

For the reasons set forth above, Applicant respectfully submits that the Examiner's rejection of claims 84-339 under 35 U.S.C. § 251 is in error and should be withdrawn.

The Examiner also rejected claims 30-83 under 35 U.S.C. § 251, alleging that merely adding dependent claims 30-83 without changing the scope of independent claims is not a correction of § 251 error. Notwithstanding the Examiner's failure to cite any authoritative basis for his allegation, Applicant submits that 35 U.S.C. § 251 clearly sets forth that "[w]henver any patent is ... deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application." (Emphasis added.) That is, correcting patent claims in a reissue application by adding claims that are narrower than the original patent claims is one of the valid and proper grounds for filing a reissue application. See *e.g.*, M.P.E.P. §§ 1402 and 1414. Each of dependent claims 30-83 has a scope narrower than that of patent claim 1 and, thus, adding claims 30-83 is completely consistent with 35 U.S.C. § 251. For at least this reason, Applicant respectfully submits that this rejection under 35 U.S.C. § 251 is in error and should be withdrawn.

Alleged Defective Reissue Declaration

The Examiner also alleged that the reissue declarations filed on October 29, 2001 and December 21, 2006 are defective because they fail to properly identify at least one 35 U.S.C. § 251 error. Specifically, the Examiner alleged that the statement in paragraph 6 of the declarations is insufficient because any error in the claims must be

identified by reference to the specific claim(s) and the specific claim language wherein lies the error. The Examiner also alleged that “[t]he differences between the newly added claims 30-339 and the original claims 1-29 must be pointed out.” Applicant disagrees with these allegations for at least the following reasons.

Paragraph 6 of the reissue declaration states that:

Independent claim 1 of U.S. Patent No. 5,918,994 recites a brush comprising, *inter alia*, at least one notch comprising at least two secant faces that “form a reentrant angle (β) of between 60° and 180° at any point along” a [trough] line. Certain aspects of the invention could be practiced without having such a configuration.

As is abundantly clear, this statement identifies an error with the required specificity. In particular, in contrast to the Examiner’s allegations, the statement identifies the error by a clear reference to the specific claim (i.e., claim 1) and the specific claim language (i.e., “form a reentrant angle (β) of between 60° and 180° at any point along” a trough line). The statement also identifies how the error renders the original patent wholly or partly inoperative or invalid (i.e., “Certain aspects of the invention could be practiced without having such a configuration”).

Regarding the Examiner’s allegation that Applicant must identify the differences between newly added claims 30-339 and the original claims 1-29, Applicant notes that the Examiner appears to have misunderstood the specificity requirement of a reissue declaration. Identifying the differences between the claims being added in the reissue application and the original patent claims, as proposed by the Examiner, would require, in effect, identification of all of the errors and the corresponding corrective actions being taken. However, there is no such requirement for identifying all of the errors being corrected or the corrective actions being taken in a reissue declaration. As 37 C.F.R.

§ 1.175(a)(1) clearly sets forth, a reissue applicant need only identify one of the errors in the reissue declaration. Also, the corrective action which has been taken in the reissue application to correct the original patent need not be identified in the declaration. Once the reissue applicant identifies one such error, as Applicant did in this case, this requirement is satisfied. See *e.g.*, M.P.E.P. § 1414 II.(B). For at least these reasons, Applicant respectfully submits that the Examiner's allegation is unfounded and should be withdrawn.

Supplemental Declaration

The Examiner required submission of a Supplemental Declaration to cover the errors corrected by Applicant's amendments filed May 16 and June 28, 2007. In response, Applicant submits, as Attachment to this paper, a Supplemental Declaration as required by the Examiner. In the Supplemental Declaration, although not required, Applicant has added a paragraph stating that "U.S. Patent No. 5,918,994 is also partially inoperative by reason of my having claimed more than I had a right to claim in certain aspects" to cover the errors being corrected by adding dependent claims 30-83.

Conclusion

In view of the foregoing reasons, Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding rejections, and allowance of all of the pending claims.

The final Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant decline to necessarily subscribe to any statement or characterization in the Office Action, regardless of whether it is addressed above.


Should the Examiner believe a telephone conversation might advance prosecution of this case, he is invited to call the undersigned at 571-203-2739.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 20, 2008

By: 
K. Kevin Mun
Reg. No. 50,585

Attachment:

- Supplemental Declaration of Jean-Louis H. Gueret (2 pages)